REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

In the present Reply, claim 1 has been amended. Thus, claims 1-18 are pending in the present application. No new matter has been added by way of the amendment to claim 1, since this amendment is supported by the present specification at least at page 34, lines 10-15.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 103(a)

Claims 1-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Fukui et al. '502 (U.S. Published Application No. 2002/0102502 A1) and Tsuji '619 (U.S. Patent No. 5,286,619) (see paragraph 2 of the outstanding Office Action).

Also, claims 1-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of EP '310 (EP 1 096 310 A2) and Tsuji '619 (see paragraph 3 of the Office Action).

Applicants respectfully traverse, and reconsideration and withdrawal of these rejections are respectfully requested.

Distinctions over the Combination of Fukui '502 and Tsuji '619, and over EP '310 and Tsuji '619

In the Office Action in paragraphs 2-3, the Examiner refers Applicants to various parts of each primary reference. Thereafter, the disclosure of the secondary reference of Tsuji '619 is discussed. Then, the Examiner essentially combines each primary reference with the secondary reference because:

> "it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the polymer latex containing the butadiene group taught in [the primary reference of either Fukui '502 or EP 310] including the use of substituents known in the formation of latex taught in Tsuji with a reasonable expectation of success of achieving a binder with good quality such as providing the material development uniformity and rapid image form, and thereby provide an invention as claimed." (see the sentence bridging pages 2-3 of paragraph 2, and page 3, lines 15-20 of paragraph 3 of the Office Action).

Applicants respectfully traverse because one of ordinary skill in the art would not combine the disclosure of the cited references as asserted in the Office Action. Specifically, one of ordinary skill in the art would not combine any asserted polymer latex in either Fukui '502 or EP '310 with any compound or substituent with Tsuji '619 because Tsuji '619 is inconsistent with either primary reference.

More specifically, Tsuji '619 fails to disclose a polymer latex or any use thereof. Instead, one of ordinary skill in the art would understand that the Tsuji '619 reference clearly discloses the opposite: usage of a water-soluble polymer (see, e.g., claim 1 of the reference at columns 27-28), which does not form polymer latex. Thus, the primary references cannot be properly combined with Tsuji '619 because there is no "formation of latex taught in Tsuji" as asserted in the Office Action. Applicants further note that the Examiner uses Tsuji '619 to

assert "it is known in Tsuji to associate the chain of polymer latex with a group other than hydrogen atom to improve development uniformity and rapid image forming" (see, e.g., page 2, lines 5-7 from the bottom of the Office Action). But as explained, there is no chain of polymer latex in Tsuji '619 and the instant combinations of references are improper.

Also, due to the use of water-soluble polymers that do not form latex, Tsuji '619 is inconsistent with either one of the primary references of Fukui '502 and EP '310. Though in the Office Action the Examiner refers Applicants to the specific compounds of II-1 to II-9 at columns 9-10 of Tsuji '619, Applicants note that each of these monomers contain $-SO_3X$ (wherein X is Na or NH_4). Thus, the (water-soluble) polymers of Tsuji '619 are not sufficient to guide one of ordinary skill in the art, upon reading either one of the cited primary references, to achieve the present invention.

Still, the Examiner refers to structural similarities between the cited references (see, e.g., the Office Action at page 3, starting at line 3 from the bottom). However, Applicants traverse such reasoning based on how Tsuji '619 is not an appropriately cited reference as discussed above.

Further, there is another inconsistency between each cited primary reference and Tsuji '619 such that one of ordinary skill in the art would not be motivated and/or reasonably expect to be successful in achieving the present invention upon a reading of these references. That is, the thermal developing system of either primary reference is markedly different or distinct from that of Tsuji '619. Specifically, the developing system used in conventional silver halide photographic photosensitive materials as used in Tsuji '619 uses a developing solution. The addition of the water-soluble polymer in Tsuji '619 is so that one skilled in the art obtains development evenness in processing using an automatic processing machine, which is known to use a developing solution. In contrast, one of ordinary skill in the art

would understand and realize that the thermal developing system as employed by Fukui '502 or EP '310 is so different from Tsuji '619 that the skilled artisan would not combine such disclosures. Even a person skilled in the art would not conceive of combining the teachings of Tsuji '619, directed to a different developing system, with the photosensitive materials for a thermal developing system as disclosed in Fukui '502 or EP '310. In other words, the skilled artisan would not combine such disclosures due to the differences in the development methods employed, as well as the ingredients in the different methods, such that the present invention would not be achieved.

Accordingly, Applicants respectfully submit that both outstanding rejections as stated in paragraphs 2 and 3 of the Office Action are improper. In this regard, if a proposal for modifying the cited reference in an effort to attain the claimed invention causes the reference to become inoperable or destroys its intended function, then the requisite motivation to make the modification would not have existed. *See In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984) (Federal Circuit stating that modifying the French apparatus as the Board suggested would render the apparatus inoperable for its intended purpose); *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); *see also In re Ratti*, 123 USPQ 349, 352 (CCPA 1959). That is the case here because the present invention would destroy the intended purpose or function of either primary reference because the skilled artisan would not combine the disclosure in Tsuji '619 (e.g., due to the secondary reference's use of a developing system, and not a thermal developing system; use of water-soluble polymers; using a developing solution; no polymer latex is used; etc.). In the alternative, the intended function of Tsuji '619 would be destroyed, or this secondary reference would be rendered inoperable, since the developing system in Tsuji '619 would have to be modified in order to achieve the present invention. Further, the water-soluble polymers in Tsuji '619 do not form latex as instantly claimed. Thus, using the

disclosure of Tsuji '619 would not render either primary reference as operable in order to achieve the present invention.

Thus, Applicants respectfully submit that the instant rejections are improper and request withdrawal thereof. U.S. case law squarely holds that a proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a claimed method or process), there would have been a reasonable expectation of success. *See In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *see also In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316-17 (Fed. Cir. 2000); *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination."). Because the required motivation is lacking, which is a requirement for a *prima facie* case of obviousness, Applicants submit that this rejection has been overcome. Also, under *In re Gordon*, Applicants respectfully submit that the requisite motivation is lacking such that a *prima facie* case of obviousness has not established.

Overall, the developing system and (water-soluble) polymers of Tsuji '619 are not sufficient to guide one of ordinary skill in the art, upon reading either one of the cited primary references, to achieve the present invention. Applicants further submit that the skilled artisan would not even initially refer to Tsuji '619 in an effort to achieve the present invention for

the reasons stated above. Further, upon reading either primary reference of Fukui '502 or EP '310, that skilled artisan would not be motivated and/or reasonably expect to achieve the present invention by referring to Tsuji '619. The polymers in Tsuji '619 do not even form latex as asserted in the Office Action and as instantly claimed. Thus, Applicants respectfully request the Examiner to reconsider the instant combinations of references as being improper, and further request withdrawal of these rejections.

Issues of Double Patenting

Claims 1-18 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/722,533 (U.S. Publication No. 2004/0121273). Applicants herein disclose a Terminal Disclaimer, thereby rendering this rejection moot. Withdrawal of this rejection is respectfully requested.

Information Disclosure Statement

Applicants filed an Information Disclosure Statement on March 31, 2004. However, Applicants have not yet received an initialed copy of the PTO1449 form having the Examiner's initials next to each cited reference. Thus, Applicants respectfully request such an initialed copy of this PTO-1449 form from the Examiner.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present

application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Dated: _____

Respectfully submitted,

By _____

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